UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,337	08/24/2006	Yong-Woo Kim	Q96705	2754

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ART UNIT	PAPER NUMBER
3691	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/598,337	KIM ET AL.
	Examiner	Art Unit	
	EDWARD CHANG	3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>November 10, 2009</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>16-19,21,23 and 24</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>16-19, 21, 23 and 24</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☒ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Status of Claims

1.   This action is in reply to the RCE filed on 10th of November 2009.

2.   Claims 1-15, 20 and 22 were canceled.

3.   Claims 16-18 were amended.

4.   Claims 16-19, 21, 23 and 24 are currently pending and have been examined.

Response to Arguments

5.   Applicant's arguments with respect to claims 16-19, 21, 23 and 24 have been considered but are

moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as
> set forth in section 102 of this title, if the differences between the subject matter sought to be
> patented and the prior art are such that the subject matter as a whole would have been obvious
> at the time the invention was made to a person having ordinary skill in the art to which said
> subject matter pertains. Patentability shall not be negatived by the manner in which the invention
> was made.

7.   The factual inquiries set forth in Graham **v.** John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966),

that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are

summarized as follows:

    1.   Determining the scope and contents of the prior art.
    2.   Ascertaining the differences between the prior art and the claims at issue.
    3.   Resolving the level of ordinary skill in the pertinent art.
    4.   Considering objective evidence present in the application indicating obviousness or
             nonobviousness.

8.   Claims 16~18, and are rejected under 35 U.S.C. 103 (a) as being unpatentable over Ronen (US

5,845,267) in view of Jamison et al. (hereinafter "Jamison"); (US 2003/019711 A1) in further view of

McNair (US 2001/0037297 A1).

As per Claim 16:

Ronen as shown discloses the following limitations:

- *extracting required information including information on the payers and the payment*
  amount from a receipt management database (See at least Fig. 1, 126) *for managing at*
  least information on payers who have to pay and payment amount that the respective
  payers have to pay for a certain period of time; and (See at least Fig. 1, 127)

- *transmitting the bill for payment to a payer receiver, and* (See at least Column 7, Line
  22+, "...Billing server to properly bill each user...")

However, Ronen discloses using a transaction server but it specifically does not mention using a

relay server. But it is commonly known in the network art to use multiple servers including a relay

server. This is also clearly shown by Jamison.

- *receiving processed payer information from a relay server, wherein the relay server*
  receives information on payers who have completed a payment process and payment
  amounts paid by the payers, transmitted from a financial institution server and selects
  information including personal details of the payers, paid amounts and paid dates, which
  a payee wants to obtain, among the received information thereby to provide the
  processed payer information. (See at least Fig. 1, EBPP SERVER = relay server, Item 62
  = historical bill payment data)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention was made to modify Ronen's internet billing system as taught by Jamison's EBPP

system to add a extra relay server to the system to collect payment data. This would give extra

processing power to further process the necessary data. This would ultimately increase the

efficiency of the system.

Also, combination of Ronen/Jamison specifically does not mention the following limitations. But McNair discloses the following limitations:

- *converting the extracted information into a two-dimensional (2D) code,* (See at least Page 3, Paragraph 0048+, "...encode the data into a barcode processing instruction...")

- *making out a bill for payment with the converted 2D code attached thereto,* (See at least Fig. 2, Item 42, 46)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Ronen/Jamison's billing system as taught by McNair's billing system aided by scanner to use the 2D code as part of the bill. This simplifies the billing process and greatly increases the effectiveness of the system.

As per Claim 17:

Ronen as shown discloses the following limitations:

- *extracting required information including information on the payers and the payment amount from a receipt management database* (See at least Fig. 1, 126) *for managing at least information on payers who have to pay and payment amount that the respective payers have to pay for a certain period of time; and* (See at least Fig. 1, 127)

- *transmitting the bill for payment to a payer receiver, and* (See at least Column 7, Line 22+, "...Billing server to properly bill each user...")

However, Ronen discloses using a transaction server but it specifically does not mention using a relay server. But it is commonly known in the network art to use multiple servers including a relay server. This is also clearly shown by Jamison.

- *receiving processed payer information from a relay server, wherein the relay server receives information on payers who have completed a payment process and payment amounts paid by the payers, transmitted from a financial institution server and selects information including personal details of the payers, paid amounts and paid dates, which a payee wants to obtain, among the received information thereby to provide the*

processed payer information. (See at least Fig. 1, EBPP SERVER = relay server, Item 62 = historical bill payment data)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Ronen's internet billing system as taught by Jamison's EBPP system to add a extra relay server to the system. This would give extra processing power to further process the necessary data. This would ultimately increase the efficiency of the system. Also, combination of Ronen/Jamison specifically does not mention the following limitations. But McNair discloses the following limitations:

- *converting the extracted information into a two-dimensional (2D) code,* (See at least Page 3, Paragraph 0048+, "...encode the data into a barcode processing instruction...")

- *making out a bill for payment with the converted 2D code attached thereto,* (See at least Fig. 2, Item 42, 46)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Ronen/Jamison's billing system as taught by McNair's billing system aided by scanner to use the 2D code as part of the bill. This simplifies the billing process and greatly increases the effectiveness of the system.

As per Claim 18:

Ronen as shown discloses the following limitations:

- *extracting required information including information on the payers and the payment amount from a receipt management database* (See at least Fig. 1, 126) *for managing at least information on payers who have to pay and payment amount that the respective payers have to pay for a certain period of time; and* (See at least Fig. 1, 127)

- *transmitting the bill for payment to a payor receiver,* (See at least Column 7, Line 22+, "...Billing server to properly bill each user...")

However, Ronen discloses using a transaction server but it specifically does not mention using a relay server. But it is commonly known in the network art to use multiple servers including a relay server. This is also clearly shown by Jamison.

- *receiving processed payer information from a relay server, wherein the relay server receives information on payers who have completed a payment process and payment amounts paid by the payers, transmitted from a financial institution server and selects information including personal details of the payers, paid amounts and paid dates, which a payee wants to obtain, among the received information thereby to provide the processed payer information.* (See at least Fig. 1, EBPP SERVER = relay server, Item 62 = historical bill payment data)

- *providing processed payer information received from the relay server to a management server, and* (See at least Fig. 3, Centralized bill center website to view the bills)

- *receiving re-processed payer information from the management server, wherein the management server receives the processed payer information, and re-processes the processed payer information in an information form that the payee wants to obtain thereby to provide the re-processed payer information.* (See at least Fig. 3, information from the EBPP SERVER is re-processed to be shown on the centralized bill center website, it does not specifically state "management server" but it is obvious that in order to operate a website, it needs to have a separate server to run the website)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Ronen's internet billing system as taught by Jamison's EBPP system to add a extra relay server to the system. This would give extra processing power to further process the necessary data. This would ultimately increase the efficiency of the system. Also, combination of Ronen/Jamison specifically does not mention the following limitations. But McNair discloses the following limitations:

- *converting the extracted information into a two-dimensional (2D) code,* (See at least Page 3, Paragraph 0048+, "...encode the data into a barcode processing instruction...")

- *making out a bill for payment with the converted 2D code attached thereto,* (See at least Fig. 2, Item 42, 46)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Ronen/Jamison's billing system as taught by McNair's billing system aided by scanner to use the 2D code as part of the bill. This simplifies the billing process and greatly increases the effectiveness of the system.

9.   Claims 19 and 21 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Ronen/McNair or Ronen/Jamison/McNair in further view of Antognini et al. (hereinafter "Antognini"); (US 2002/0023055 A1).

As per Claim 19:

Combination of Ronen/McNair or combination of Ronen/Jamison/McNair discloses the limitations as shown in the rejections above. However they don't disclose the following limitations. But, Antognini discloses the following limitations:

- *wherein when an automated teller machine (ATM) is provided with the bill for payment and payment means from the respective payers,* (See at least Page 7, Paragraph 0062+, "...take those bills to an ATM...")
- *and scans and decodes the 2D code of the bill, the financial institution server implements a payment process using the decoded information and the payment means provided from the ATM, and transfers the paid payment amount to an account of the payee.* (See at least Page 7, Paragraph 0062+, "...ATM's scanner...", it does not specifically state 2D code, but 2D code is just one form of digital data mentioned by Antognini)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Ronen/ McNair's internet billing system as taught by Antognini's billing system aided by scanner to use the ATM with the scanner to process the billing. This would help payers to easily make necessary payments on time with their near by ATM.

As per Claim 21:

Combination of Ronen/McNair discloses the limitations as shown in the rejections above. However Ronen/McNair doesn't disclose the following limitations. But, Antognini discloses the following limitations:

- *wherein the payer information provided from the financial institution server to the relay server is either the 2D code attached to the bill for payment or decoded information of the 2D code attached to the bill for payment.* (See at least Page 5, Paragraph 0053+, "...electronic mail with an attachment that contains digital information...")

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Ronen/ McNair's internet billing system as taught by Antognini's billing system aided by scanner to use the ATM with the scanner to process the billing. This would help payers to easily make necessary payments on time with their near by ATM.

10.   Claims 23 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Ronen/McNair or Ronen/Jamison/McNair in further view of Kitchen et al. (hereinafter "Kitchen"); (US 6,289,322 B1).

As per Claim 23:

Combination of Ronen/McNair or combination of Ronen/Jamison/McNair discloses the limitations as shown in the rejections above. However they don't disclose the following limitations. But, Kitchen discloses the following limitations:

- *Further comprising making out a notice of arrears when a payee server has not been provided with payer information until the payment due date, and transmitting the notice of arrears to the receiver of the payer.* (See at least Page 10, Paragraph 0045+, "...reminder notice could be sent...", although it does not specifically wait until the payment due date (instead it is sent just prior to due date), but this is a obvious modification of the art because it is common practice to send a notice when the payment is late.)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Ronen/ McNair's internet billing system as taught by Kitchen's electronic billing system to message the payer when the payment is late. This would help alert the payers to make necessary payments to avoid late fees.

11.   Claim 24 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Ronen/Jamison/McNair in further view of Budow et al. (hereinafter "Budow"); (US 5,661,517).

As per Claim 24:

Combination of Ronen/Jamison/McNair discloses the limitations as shown in the rejections above.   However Ronen/Jamison/McNair doesn't disclose the following limitations. But, Budow discloses the following limitations:

- *wherein the payment process further comprises, the steps of comparing the payment amount that the respective payers have to pay for a certain period among decoded information with the total amount payable from payment means; if the payment amount is the same as or less than the total amount, subtracting the money corresponding to the payment amount from payment means and displaying a screen of the ATM a message informing of a normal completion of payment; and if the payment amount is greater than the total amount, displaying the screen a message informing of payment disable is implemented.* (See at least Column 26, Line 66+, "...account (debit or ATM)...inform the customer that the debit card account has insufficient funds...", if TV could display the information, than it is obvious and well know in the art to have ATM display such information); (Also see at least Column 16, Line 36+, "...transmit screens notifying the customer that card was approved and that the transaction is being completed...")

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Ronen's internet billing system as taught by Budow's billing system

to let the user know if there is sufficient or insufficient fund in the account to pay the bill. This would help users to effectively manage their accounts.

Conclusion

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Edward Chang** whose telephone number is **571.270.3092.** The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm.   If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **ALEXANDER KALINOWSKI** can be reached at **571.272.6771**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://portal.uspto.gov/external/portal/pair <http://pair-direct.uspto.gov >. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

P.O. Box 1450
Alexandria, VA 22313-1450

or faxed to **571-273-8300**.

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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January 15, 2010
/Edward Chang/ Examiner, Art Unit 3691
/Alexander Kalinowski/
Supervisory Patent Examiner, Art Unit 3691